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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,739	08/07/2001	Shigehiro Miyashita	Q65752	9599

7590 10/06/2005

SUGHRUE, MION, ZINN  
MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER
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ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/922,739

Applicant(s)

MIYASHITA, SHIGEHIO

Examiner

Md S. Elahee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-9, 11-13, 15, 23-27 and 29-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-13, 15, 23-27 and 29-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/07/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 07/18/05. Claims 1-3, 5-9, 11-13, 15, 23-27 and 29-38 are pending. Claims 4, 10, 14, 16-22 and 28 have been cancelled. Claims 29-38 have been added.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-3, 5-9, 11-13, 15 and 23-27 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. Claims 1-5, 8-15, 27 and 29-38 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent No. 6,064,880) in view of Iijima et al. (U.S. Patent No. 5,787,343).

Regarding claims 1, 34 and 38, Alanara teaches a mobile station 10 [i.e., mobile phone] (fig.2).

Alanara further teaches a BMI [i.e., directory server] remote from the mobile station (fig.2).

Alanara further teaches a storage unit configured to store SCM backup data [i.e., records in a replica directory], each of the data [i.e., records] including data of a telephone number, a name and an address [i.e., contact] (abstract; fig.2, 3A; col.5, lines 1-19, 30-32).

Alanara further teaches a communication control unit, configured to refer to the SCM backup [i.e., directory] to determine whether or not a requested connection of a contact to the mobile phone is permitted (abstract; col.4, line 49-col.5, line 19, lines 30-32).

Alanara does not specifically teach an indicator which indicates whether a connection to the contact is permitted. Iijima teaches a call permission flag [i.e., indicator] which indicates whether a connection to the contact is permitted (fig.5; col.8, lines 26-39). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara to incorporate an indicator which indicates whether a connection to the contact is permitted as taught by Iijima. The motivation for the modification is to have doing so in order to enable a particular subscriber to selectively receive a call.

Regarding claims 2, 29-33, 35, Alanara teaches a storage unit, configured to store records in a directory, each record contains at least a name, a phone number or an e-mail address of a contact, (abstract; col.4, line 49-col.5, line 19, lines 30-32).

Alanara further teaches an operation section configured to generate an upload instruction in response to an operation by a user of the mobile phone (col.4, line 49-col.5, line 19, lines 30-32).

Alanara further teaches a transmitting section, configured to transmit the records in the directory of from the mobile phone to the directory server in response to the upload instruction such that the records in the directory of the mobile phone is stored in the directory server as the records in the replica directory (abstract; fig.3A; col.4, line 49-col.5, line 19, lines 30-32, 47-67, col.6, line 1).

Regarding claims 3, 9 and 13, Alanara teaches that each record in the directory of the mobile phone includes edit flag (col.5, lines 1-19).

Alanara teaches the mobile phone further comprising a keypad [i.e., editing section] configured to edit at least one of the records and to set the edit flag in the edited records in response to an operation by the user (fig.1; col.5, lines 1-19).

Alanara further teaches that a transmitting section of the mobile phone configured to transmit the edited records to the directory server in response to upload instruction such that the edited records are stored as records in the replica directory in the directory server (col.4, line 49-col.5, line 19, lines 30-32).

Regarding claims 5, 15 and 36 are rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claims 8 and 12 are rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claim 5. Furthermore, Alanara teaches that the operation section is configured to generate a download instruction in response to an operation by the user and the transmitting section is configured to transmit the download instruction to the directory server (abstract; col.4, line 49-col.5, line 19, lines 30-32, 47-67, col.6, line 1).

Regarding claim 27 is rejected for the same reasons as discussed above with respect to claims 1 and 3.

Regarding claim 37, Alanara teaches the requested connection is for a phone call (col.3, lines 26-28).

6. Claims 23-26 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. (U.S. Patent No. 6,256,515) in view of Iijima et al. (U.S. Patent No. 5,787,343).

Regarding claim 23, Cox teaches in response to a communication request from a contact, referring to a directory of records, each record comprising data of a contact, determining whether or not a communication with the contact is approved (i.e., permitted) (abstract; col.3, lines 5-37, col.4, lines 42-62, col.7, lines 16-25).

Cox further teaches connecting a communication from the contact or discarding the communication from the contact based on the determination (abstract; col.3, lines 5-37, col.4, lines 42-62).

Cox does not specifically teach an indicator which indicates whether a connection to the contact is permitted. Iijima teaches a call permission flag [i.e., indicator] which indicates whether

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a connection to the contact is permitted (fig.5; col.8, lines 26-39). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cox to incorporate an indicator which indicates whether a connection to the contact is permitted as taught by Iijima. The motivation for the modification is to have doing so in order to enable a particular subscriber to selectively receive a call.

Regarding claim 24, Cox teaches that each record comprises a phone number (abstract; col.3, lines 5-37, col.4, lines 42-49).

Regarding claim 25, Cox teaches that requested communication is a phone call from a contact (abstract; col.3, lines 5-37, col.4, lines 42-49).

Regarding claim 26, Cox teaches that the communication communication is an e-mail address from a contact (col.9, lines 21-26).

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent No. 6,064,880) in view of Iijima et al. (U.S. Patent No. 5,787,343) further in view of Cox et al. (U.S. Patent No. 6,256,515).

Regarding claim 6 is rejected for the same reasons as discussed above with respect to claims 1 and 37. Furthermore, Alanara teaches each record, stored in the replica directory of the directory server, comprises a phone number of a contact (col.5, lines 1-19).

Alanara in view of Iijima does not specifically teach a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is reset when a phone call from the corresponding contact should be connected. Cox teaches a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is reset when a phone call from the corresponding contact should be

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connected (abstract; fig.3; col.3, lines.5-37). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara in view of Iijima to incorporate a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is reset when a phone call from the corresponding contact should be connected as taught by Cox. The motivation for the modification is to have doing so in order to manage unofficial calls.

Alanara in view of Iijima does not specifically teach a switching apparatus which connects a phone call from a contact to the mobile phone if the communication control unit determines that the connection is permitted and to discard a phone call from a contact if the communication control unit determines that the connection is not permitted. Cox teaches a switching apparatus which connects a phone call from a contact to the mobile phone if the communication control unit determines that the connection is permitted and to inherently discard a phone call from a contact if the communication control unit determines that the connection is not permitted (abstract; fig.3; col.3, lines 5-37). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara in view of Iijima to incorporate a switching apparatus which connects a phone call from a contact to the mobile phone if the communication control unit determines that the connection is permitted and to discard a phone call from a contact if the communication control unit determines that the connection is not permitted as taught by Cox. The motivation for the modification is to have doing so in order to manage unapproved calls. (Note; if caller's entered personal code does not match it is inherent that the caller will not get connection with the called party)



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8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent No. 6,064,880) in view of Iijima et al. (U.S. Patent No. 5,787,343) further in view of Cox et al. (U.S. Patent No. 6,256,515) further in view of Fernandez et al. (International Pub. No. WO 99/65256).

Regarding claim 7 is rejected for the same reasons as discussed above with respect to claim 6. Furthermore, Alanara in view of Iijima does not specifically teach that the requested connection is for an e-mail. Cox teaches that the requested connection is for an e-mail and an e-mail address of a contact (col.9, lines 21-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara in view of Iijima to incorporate the requested connection being for an e-mail and an e-mail address of a contact as taught by Cox. The motivation for the modification is to have doing so in order to generate reports from the call record so that an organization can have a record of approved telephone numbers.

Alanara in view of Iijima further in view of Cox fails to teach that a non-permission flag which is set when an e-mail from the corresponding contact should not be delivered to the mobile phone and a mail server configured to deliver an e-mail from a contact to the mobile phone if the communication control unit determines that the connection is permitted and to discard an e-mail from a contact if the communication control unit determines that the connection is not permitted. Fernandez teaches that a non-permission flag which is set when an e-mail from the corresponding contact should not be delivered to the mobile phone and an e-mail forwarding system [i.e., mail server] configured to deliver an e-mail from a contact to the mobile phone if the communication control unit determines that the connection is permitted and to

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discard an e-mail from a contact if the communication control unit determines that the connection is not permitted (abstract; page 5, lines 21-26, page 13, lines 24-26, page 15, lines 2-8, page 18, lines 25-31, page 19, lines 7-20). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara in view of Iijima further in view of Cox to incorporate a non-permission flag which being set when an e-mail from the corresponding contact should not be delivered to the mobile phone and a mail server configured to deliver an e-mail from a contact to the mobile phone if the communication control unit determines that the connection is permitted and to discard an e-mail from a contact if the communication control unit determines that the connection is not permitted as taught by Fernandez. The motivation for the modification is to have doing so in order to remove unauthorized e-mail notification messages from transmitting to a particular recipient.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Marks et al. (U.S. Pub. No. 2003/0167202) teach Methods of payment for internet programming, and Ezuriko (U.S. Pub. No. 2002/0032017) teach Automatic radio wave output limiting system for portable telephone set and Guimont et al. (U.S. Patent No. 6,052,593) teach Method for frequency mode validation for, frequency assignment for, and evaluating the network effect of a frequency plan revision within a dual mode cellular telephone system.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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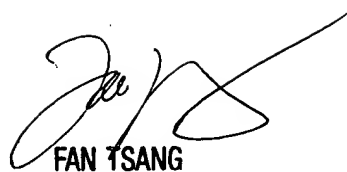
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M. E.

MD SHAFIUL ALAM ELAHEE

September 28, 2005

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a long horizontal stroke extending to the right.

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600